REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed October 19, 2005. In the Action, the Examiner notes that claims 1-12, 14-33, 35-44, and 46-57 are pending, of which claims 1-12, 14-33, 35-44, and 46-57 stand rejected.

In view of the following discussion, Applicants believe that all of the claims are allowable. It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

REJECTIONS

35 U.S.C. §103

Claims 1-12, 14-33, 35-44 and 46-57

The Examiner has rejected claims 1-12, 14-33, 35-44 and 46-57 under 35 U.S.C. §103(a) as being unpatentable over Herz U.S. 6,029,195 (hereinafter "Herz") in view of Rooney U.S. 6,819,669 (hereinafter "Rooney"). Applicants respectfully traverse the rejection.

Applicants' independent claim 1 recites (AND independent claims 17, 22, 35, and 46 recite similar relevant limitations):

> 1. A method of predicting the behavior of a current user of an interactive television service, comprising the steps of:
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> identifying, by a set top box, each activity in which the current user participates while engaged with the interactive television service, and conditions surrounding each such activity;
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> accessing, by a set top box, a first collection of data that reflects (i) cumulative activities in which other users have participated, (ii) conditions surrounding such other users' cumulative activities, and (iii) patterns of behavior exhibited by such other users through their participation in such cumulative activities, the activities including viewing interactive television programming;
>
> comparing, by a set top box, (i) the current user's identified activities and surrounding conditions and (ii) the other users' cumulative

activities and surrounding conditions, to identify similarities therebetween; and

attributing, by a set top box, to the current user a pattern of future behavior based on such similarities and on the other users' patterns of behavior.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Herz and Rooney references alone or in any permissible combination fail to teach or suggest Applicants' invention as a whole.

Herz fails to disclose the claimed accessing, by a set top box, a first collection of data that reflects (i) cumulative activities in which other users have participated, (ii) conditions surrounding such other users' cumulative activities, and (iii) patterns of behavior exhibited by such other users through their participation in such cumulative activities, the activities including viewing interactive television programming.

By contrast, Herz discloses matching users who share a high level of interest in particular multi-user applications or the particular type of content in those multi-user applications. (Herz, col. 89, lines 25-27.) Specifically, users are "matched according to their common interest in a type of application which can be jointly interacted with or jointly viewed passively". (Herz, col. 90, lines 10-22.) This is not the same as the claimed invention. The common interest in Herz is in an application that can be jointly interacted with or jointly viewed passively. The claimed invention collects data on patterns of behavior of users in their cumulative activities, not joint activities. The claimed invention is collecting data on a current user and comparing the data about the current user with other users doing similar things, not the current user jointly doing things with the other users. Moreover, the common interests are not limited to multi-user applications.

In addition, Herz fails to disclose the claimed comparing (i) the current user's identified activities and surrounding conditions and (ii) the other users' cumulative activities and surrounding conditions, to identify similarities therebetween.

Herz discloses comparing "target profiles" of "target objects" with "search profiles" of users. (Herz, col. 7, lines 9-18). Herz is not comparing the same things as the claimed invention. Herz defines "target objects" as "an object available for access by the user" and "target profiles" as "a digitally represented profile indicating that target object's attributes". (Herz, col. 4, lines 49-53). Herz defines a "search profile" as "a profile consisting of a collection of attributes, such that a user likes target objects whose profiles are similar to this collection of attributes". (Herz, col. 4, lines 57-61).

By contrast, the claimed invention compares the current user's identified activities and surrounding conditions with the other users' cumulative activities and surrounding conditions. The current user's identified activities and surrounding conditions are different than the "target profiles" of "target objects", because the user is not an object available for access; by contrast the user is the one doing the accessing. Other users' cumulative activities and surrounding conditions are not "search profiles", because activities are not attributes; attributes are generalized qualities, while activities are specific tasks.

Therefore, Herz fails to disclose at least these elements of claim 1. Thus, claim 1 is not anticipated by Herz.

The Rooney reference fails to bridge the substantial gap between the Herz reference and Applicants' invention. The Rooney reference discloses a set top box 104 is provided for allowing the user to interact with the program shown on the television set 102. (Rooney, col. 3, lines 64-66.) Because Herz fails to disclose all the elements of claim 1 and Rooney fails to disclose those missing elements, the combination also fails to disclose all the elements of claim 1.

As such, Applicants submit that independent claims 1, 17, 22, 35 and 46 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2-12, 14-16, 18-21, 23-33, 36-44 and 47-57 depend, either directly or indirectly, from independent claims 1, 17, 22, 35 and 46 and recite additional limitations thereof. As such and at least for the same reasons as discussed

above, the Applicants submit that these dependent claims are also non-obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

CONCLUSION

Thus, Applicants respectfully submit that all of the claims are allowable. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Lea A. Nicholson at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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